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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,792

09/27/2005

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EXAMINER

THEODORE, MAGALI P

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,792	Applicant(s) SCHMID ET AL.	
	Examiner Magali P. Théodore	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/26/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5, 8-12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciba-Geigy (GB 1,389,238).

Regarding claim 1, Ciba-Geigy teaches a process for the preparation of condensed resins in powder form, wherein the condensation of at least one crosslinkable starting material which is liquid or dissolved in a liquid phase with at least one aldehyde (p 1 ln 72-76) is carried out in a spray reactor (p1 ln 39).

Regarding claim 2, Ciba-Geigy teaches that the condensation is carried out within the range of 20 °C to 150 °C (p 8 ln 68-70).

Regarding claim 5, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Regarding claims 8-9, Ciba-Geigy teaches a mean particle diameter between 50 and 300 microns (p 5 ln 120-122).

Regarding claim 10, Ciba-Geigy teaches that the starting materials are mixed prior to spraying and are kept at within a range between -40 °C to 30 °C (p 8 ln 57-58).

Regarding claim 11, Ciba-Geigy teaches that wherein the starting material used is melamine (p 1 ln 47) or urea (p 8 ln 54).

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Regarding claim 12, Ciba-Geigy teaches that the aldehyde used is formaldehyde (p 8 ln 56).

Regarding claim 18, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 13-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ciba-Geigy.

Regarding claim 13, Ciba-Geigy teaches a condensate (p 8 ln 69).

The disclosed product of Ciba-Geigy and the instantly claimed product appear to be essentially the same, comprised of the same components, and used in the same manner. In the event any differences can be shown for the product of the product-by-process claim 13 as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Regarding claim 14, Ciba-Geigy teaches a condensate (p 8 ln 69). The examiner recognizes that the claimed moisture content is not positively stated by the reference. However, since the reference discloses all of the claimed ingredients, process steps and process conditions, the claimed moisture content would inherently be achieved by carrying out the disclosed process. If it is Applicant's position that this would not be the case: (1) evidence would need to be presented to support applicants' position; and (2) it

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would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only these steps.

In the event any differences can be shown for the product of the product-by-process claim 14 as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Claim Rejections - 35 USC § 103

7. Claims 3, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba-Geigy as applied to claim 1 above and further in view of Thiesse et al. (US 5,807,584), henceforth Thiesse.

Regarding claims 3, Ciba-Geigy does not teach a nozzle size. However, Thiesse establishes nozzle size as a result effective parameter by teaching that the nozzle diameter is always smaller than the size of the particle it makes. Therefore it would have been obvious to one of ordinary skill in the art to optimize the size of the orifice in Ciba-Geigy's method because Thiesse teaches that the size of the nozzle determines the size of the particle formed. Optimizing a result-effective parameter known in the art

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does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 15, Ciba-Geigy does not teach a nozzle size. However, Thiesse establishes nozzle size as a result effective parameter by teaching that the nozzle diameter is always smaller than the size of the particle it makes. Therefore it would have been obvious to one of ordinary skill in the art to optimize the size of the orifice in Ciba-Geigy's method because Thiesse teaches that the size of the nozzle determines the size of the particle formed. Optimizing a result-effective parameter known in the art does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 19, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

8. Claims 4, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba-Geigy as applied to claim 1 above and further in view of Levendis et al. (US 5,269,980), henceforth Levendis.

Regarding claim 4, Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Regarding claim 16, Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Regarding claim 20, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba-Geigy.

Ciba-Geigy does not specify the pressure at condensation. However, Ciba-Geigy establishes pressure as a result effective parameter by teaching that pressure affects the dispersion and secondary agglomeration of the droplets (p 5 ln 73-75). Therefore it would have been obvious to one of ordinary skill in the art to optimize the size of the pressure in Ciba-Geigy's method because Ciba-Geigy teaches that pressure determines the droplets' dispersion and secondary agglomeration. Optimizing a result-effective parameter known in the art does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba-Geigy in view of Thiesse as applied to claim 3 above, and further in view of Levendis.

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Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magali P. Théodore whose telephone number is (571) 270-3960. The examiner can normally be reached on Monday through Friday 9:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P. T./
Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791